



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,101	07/01/2003	Brian Carvill	128553-1/GP1-0117	3430

43248 7590 08/12/2005

CANTOR COLBURN LLP  
55 GRIFFIN RD SOUTH  
BLOOMFIELD, CT 06002

EXAMINER
----------

SHIPPEN, MICHAEL L

ART UNIT	PAPER NUMBER
----------	--------------

1621

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/612,101

**Applicant(s)**

CARVILL ET AL.

**Examiner**

MICHAEL L. SHIPPEN

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

500

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

Claims 1-3, 5-7, 9, 10, 11, 12 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,302,774 for reasons of record. Contrary to applicants' assertion the reference does carry out the reaction at a variety of water concentrations. While each run in the examples is carried out at a single water concentration, this does not distinguish the claims from the prior art. The claims do not require an adjustment in a single run process. Moreover, the reference clearly teaches that the selectivity is effected by the water concentration. Anybody practicing the prior art process obtaining a selectivity that is not desired would change the water concentration to afford the desired selectivity. For example, one optimizing the prior art process to afford maximum selectivity to the desired product.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,302,774, JP 57-31629, JP 10-21257 or JP 10-251180 for reasons of record. Contrary to applicants' assertion, it is considered that the amount of water is adjusted based on the amount of catalysts and its activity. The flow rates of reagents in such processes depends, among other things, on the amount of catalysts and its activity. Too high a flow rate based on these factors would not afford optimum conversion of the reactants. Too low a flow rate would not be time efficient. These properties of the catalysts in effect determine the flow rate of all the reagents including the water, i.e., the amount of water that would be introduced into the reaction zone over time.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by USP 5,302,774, JP 57-31629, JP 10-21257 or JP 10-251180 for reasons of record. The fact that the claims recite property of the reaction stream that is inherent in the prior art processes does not distinguish the claim from the prior art process. The claimed process and the prior art process are one and the same regardless of whether the reference recognized the inherent property.

***Claim Rejections - 35 USC § 103***

Claim 1-23 rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,302,774 in view of USP 4,400,555, USP 4,822,923, USP 4,859,803 and admitted prior art<sup>1</sup> for reasons of record and reasons given above. Applicants' arguments are the same as addressed above and are not found persuasive for the reasons stated above.

Claim 24 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,302,774, JP 57-31629, JP 10-21257 and JP 10-251180 in view of admitted prior art<sup>2</sup> for reasons of record and the reasons stated above. Applicants' arguments are the same as addressed above and are not found persuasive for the reasons stated above.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,302,774, JP 57-31629, JP 10-21257 or JP 10-251180 for reasons of record and the

---

<sup>1</sup> The admitted prior art is that bisphenol A is a known monomer for the preparation of polycarbonates, see Section [0002] of the specification.

<sup>2</sup> The admitted prior art is that bisphenol A is a known monomer for the preparation of polycarbonates, see Section [0002] of the specification.

Art Unit: 1621

reasons stated above. Applicants' arguments are the same as addressed above and are not found persuasive for the reasons stated above.


***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(571) 272-0647**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(571) 272-1600**. The official group FAX machine number is **571-273-8300**.

MShippen  
August 8, 2005

  
**MICHAEL L. SHIPPEN**  
**PRIMARY EXAMINER**  
**ART UNIT 1621**